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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,566	05/07/2001	Anton Negele	205892USOPCT	1079

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

5

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,566	NEGELE ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05/07/01;07/12/01.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Priority

1. **Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.**

Information Disclosure Statement

2. **The information disclosure statement filed 07/12/01 have been considered and placed in the application file.**

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) The recited "if desired" per claim 5 constitutes indefinite subject matter as per it not being readily ascertainable as to if or how said objectionable phrase further limits the claims.

B) The recited "from 5 to 80 parts by weight of N-vinylformamide and/or N-vinylacetamide" per claim 5 and "from 10 to 50 parts by weight of N-vinylformamide and/or vinylacetamide" per claim 6 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact compound that the recited content range is intended to qualify, i.e., "N-vinylformamide" only or the recited "N-vinylacetamide" also.

C) *The recited "azocompounds" per claim 6 should read "azo compounds" so as to engender claim language clarity.*

D) *The recited "the polymeric dispersants" per claim 7 engenders the non-expression of proper antecedent basis, i.e., "dispersants"/"dispersant".*

Claim Rejections - 35 USC § 102

5. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. *Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fong et al(U.S. 6,426,383).*

Fong et al disclose and exemplify water-soluble N-vinylamide polymers dispersions obtained via basically polymerizing, in an aqueous medium, N-

vinylamide monomers such as N-vinyl formamide, N-vinyl acetamide and N-methyl-N-vinylacetamide(alone) or in combination with other ethylenically unsaturated monomers such as vinyl pyrrolidone, vinyl acetate, etc, in the presence of a free-radical initiator and a stabilizer which includes polyvinyl alcohol, polydiallyldimethylammonium chloride, etc. See, e.g., the Abstract, cols. 3-15, the Runs and claims of Fong et al. Fong et al therefore anticipate the instantly claimed invention, in both content and character.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.***
- 2. Ascertaining the differences between the prior art and the claims at issue.***
- 3. Resolving the level of ordinary skill in the pertinent art.***
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.***

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 *t* point out th inventor and invention dates of ach claim that was not commonly owned at th time a later invention was mad in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. *Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fong et al(U.S. 6,426,383) in combination with Matsushima et al(U.S. 5,936,042).*

Fong et al is as discussed *supra* and applied to claims 1-7. Further, the disclosure of **Fong et al** differs basically from the claimed invention as per the non-express recognition of using, as a dispersant/stabilizer, those as recited per claim 8. However, **Matsushima et al** disclose similar such processes which involve homo- or copolymerizing N-vinylcarboxylic acid amide monomers such as N-vinylformamide, N-vinylacetamide, etc. in an aqueous medium and in the presence of a dispersant/stabilizer such as polyvinyl alcohol, polyethyleneimine, polyethylene glycol See, e.g., the Abstract, cols. 2, 3 and 6, the Runs and claims of **Matsushima et al**. Therefore, one having ordinary skill in the art would have found it obvious, on its face, to use other stabilizers/dispersants such as polyethyleneimine and polyethylene glycol in addition to or in lieu of the polyvinyl alcohol, based on their disclosed equivalency, and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.

Conclusion

12. *The prior art made of record and not relied upon is cited as of interest in teaching compositions similar to the claimed aqueous dispersions and considered merely cumulative to the prior art supra.*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR/jrl
September 9, 2002